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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,494	06/24/2003	Ekapot Bhunachet		3532

7590 10/14/2005  
Ekapot Bhunachet  
2-32-22 Kasuga  
Tsukuba  
Ibaraki, 305-0821  
JAPAN

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/603,494	Applicant(s) BHUNACHET, EKAPOT	
	Examiner Anthony Stashick	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the claims contains the phrase “(including boots, sneakers, slippers and sandals)” which renders the claims vague and indefinite. It is not clear whether the term “shoes” is meant to encompass all shoes or only those listed in the “including” statement. If all shoes are meant to be encompassed, that portion set off in parentheses can be deleted from each of the claims, as the term “shoes” is understood to cover all types of footwear. Also, the phrase in claim 5 “as he stands straight on a flat ground on his bare feet with the toe intentionally and completely lifted up...”. It is not clear as to whether the applicant is claiming a user in his bare feet or doing a comparison of a user in his bare feet to the instant invention. With respect to claim 8, the phrases including the previous claims render the claim vague and indefinite. It is not clear whether applicant is writing this as a dependent claim or an independent claim and saying that they are “originally different from those of shoes as claimed in claims 5, 6 and 7 to the same structure as the shoes ...”. It is not clear how they can be different and the same structure. The addition of “one step” to claim 6 appears to be new matter. There is no support for this limitation in the application as originally filed.

### ***Claim Rejections - 35 USC § 102***

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen 5,940,994. Allen '994 discloses all the limitations of the claims including the following: shoes designed so that when a man wears these shoes and stands straight on flat ground, his heels are as high as the sole (see Figure 10 and 12) and the body weight does not fall on the toes; the toes are completely lifted up (see front portion of Figures 10 and 12); the heel and sole parts of the shoe soles are at the same height and higher than the toe part (see Figures 10 and 12); the base structure of the toe part is curved up from the ground (see Figure 7 at toe area).

3. Claims 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by the PCT reference to Melcher WO 87/06801 (WO '801). WO '801 discloses all the limitations of the claims including the following: shoes designed so that when a man wears these shoes and stands straight on flat ground, his heels are as high as the sole (see Figure 1) and the body weight does not fall on the toes; the toes are completely lifted up (lifted off the ground, Figure 1); the heel and sole portions of the shoe are at the same height without the shoe sole under the toes (see Figure 1).

4. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Lustig 2,097,930. Lustig '930 discloses all the limitations of the claim including the following: an insole pad used to heighten the sole part of a user's foot and not the toe part (see Figure 1).

*Response to Arguments*

5. Applicant's arguments filed July 28, 2005 have been fully considered but they are not persuasive. Firstly, the claims presented are not significantly different than those originally presented. Applicant has only added functional language while claiming the product. Therefore, the references applied read on the product claimed and can perform the functions added since the user only need to be a heel striker, where the user's weight doesn't "automatically" fall on the user's toes. Furthermore, the addition of "one step" to the claims does not further define the change in height as this "one step" was not defined in the specification in such a way that one can determine what is meant by this phrase. Applicant argues that the shoe in Figure 7 of Allen '994 has a sole, of which the toe part and the sole part are lower than the heel part and that this does not meet the limitations of the claims. Figures 10 and 12 clearly show the toe portion higher than the heel and sole portions. Applicant further argues that Melcher (WO '801) does not meet the limitations of the claims because it states that the user of the shoe is allowed to have the weight distribution and the walking and running motion as natural as walking and running on bare feet. Applicant states that his invention makes it so that "when he walks or runs the body weight automatically does not fall on the toes as he walks or runs on his bare feet with the toe intentionally and completely lifted up." Since WO '801 teaches its use as that of a person in bare feet, it would meet this limitation of the claims as it can act as one who intentionally lifts his toe when he walks. Furthermore, applicant assumes that the sole of WO '801 has to be flat and thin in order to be flexible. This argument appears to be an assumption based on evidence not

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provided. For the most part, if the sole of WO '801 was flat and thin, there would not need to be any cut lines since cut lines are usually put on thicker sole to aid in making them flexible whereas thinner sole already impart some flexibility. Also, the assumption that the sole of WO '801 is thin and therefore does not prevent the body weight from falling on the toes is unsupported. With respect to applicant's argument that the sole and heel of WO '801 is not at the same height, this can be clearly seen in Figure 1 of the references. Lastly, applicant has admitted that changing the shoe sole structure by using the innersole "is not a new technique", applicant has admitted that it is not inventive.

### *Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

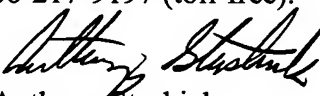
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561.

The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS